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Paper 46

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AUG 06 2008

**OFFICE OF PETITIONS**

ON PETITION

In re REISSUE PATENT NO. RE38,216 :  
Issue Date: August 12, 2003 :  
Application No. 09/174,804 :  
Filed: October 19, 1998 :  
Title of Invention: **SCOOPED LACROSSE** :  
**HEAD** :

This is a decision on the Request for Reconsideration, filed January 8, 2008 under 37 CFR 1.378(e), of a prior decision mailed December 3, 2007, refusing to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(e) is **DENIED**.<sup>1</sup>

BACKGROUND

The original patent issued October 29, 1996. The second maintenance fee due could have been paid during the period from October 29, 2003 through April 29, 2004 or with a surcharge during the period from April 30, 2004 through October 29, 2004. This patent expired on October 29, 2004 for failure to timely remit the second maintenance fee.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on May 12, 2006 in which petitioners asserted that the delay was unavoidable because in spite of a properly functioning docketing system and in spite of assurances from an otherwise reliable staff person that the second maintenance fee had been paid, the maintenance was not paid. Petitioners claim that no Notice of Expiration was received from the United States Patent and Trademark Office (USPTO) and they only learned that the patent had expired as a result of a lawsuit filed in a matter related to the instant patent.

The petition was dismissed in a decision mailed December 3, 2007 for failure to provide a sufficient showing that the delay in paying the maintenance fee was unavoidable. While petitioners argued that their reliance on an otherwise reliable employee, whose mental and physical condition caused her to not pay the maintenance fee as instructed, was the cause

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<sup>1</sup>This decision may be regarded as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

of the unavoidable delay, the evidence provided was not sufficient. Petitioners' argument that payment of the maintenance fee was a clerical function reasonably expected to be performed by Latitia Ford and that the failure to pay the maintenance fee was a clerical error in the course of her duties, could not be supported by the party responsible for payment of the maintenance fee as to what steps were in place for ensuring timely payment of the maintenance fee and why action was not taken to timely submit the required maintenance fee because unfortunately, Ms. Ford succumbed to the illnesses that petitioners claim caused her failure to pay the maintenance fee.

The decision dismissing the petition required a documented showing, how the failure to pay the maintenance fee was due to a clerical error.

The instant petition under 37 CFR 1.378(e) purports to provide additional explanations as to why petitioners believe the payment of the second maintenance fee was delayed and why that delay was unavoidable.

#### STATUTE AND REGULATION

35 USC 41(c)(1) states that:

The Director may accept the payment of any maintenance fee required by subsection (b) of this section after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee.

#### OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 USC 41(c)(1).

Acceptance of a late maintenance fee on the basis of unavoidable delay is considered under the same standard as that for reviving an abandoned application under 35 USC 133 because 35 USC 41(c)(1) uses the identical language, i.e., "unavoidable" delay. Ray v.

Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912)("The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioners' request for reconsideration states that the payment of the maintenance fee was a clerical function and the responsibility of Ms. Ford. The request for reconsideration also states that while they believe that Ms. Ford's underlying illness caused her to not pay the maintenance fee as instructed in accordance with her job duties and responsibilities, the Artz Firm was unaware of the illness and the fact that she had not paid the maintenance fees as instructed.

Petitioners' arguments and evidence, includes a statement from Ms. Ford's mother (Annie Hubbard) that states that not even Ms. Ford's family was aware of her illness. These statements have been considered, but are not found to be sufficient to meet the burden of establishing unavoidable delay. As petitioners conclude that they had a docketing system for ensuring that maintenance fees would be paid, that Ms. Ford was otherwise reliable and that her fatal illness had to be the reason for her failure to follow through in her normal reliable course of conduct. Petitioners have not established by way of medical records, statement from a medical professional or a death certificate that there was any causal relationship between Ms. Ford's illness during the relevant period, and her failure to pay the maintenance fee when due. Since Ms. Ford is not available to confirm what happened in this instance the record is devoid of the required showing of the steps taken to ensure timely payment of the maintenance fee.

While docket/clerical error may be construed as unavoidable, petitioners have failed to provide facts to warrant such a finding. A delay resulting from an error on the part of an employee in the performance of a clerical function may provide the basis provided it is shown 1) the error was the cause of the delay; 2) there was in place a business routine for performing the clerical function which could reasonably be relied upon to avoid errors in its performance and 3) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

However, clerical error in the form of careless mistakes or the result of a lack of knowledge

of USPTO practices and procedures would not establish unavoidable delay.<sup>2</sup>

An adequate showing of unavoidable delay due to docket/clerical error may include but not limited to:

- 1) *statements by all parties with direct knowledge of the circumstances surrounding the delay;*
- 2) *a thorough explanation of the docketing system in use;*
- 3) *identification of the types of records kept;*
- 4) *identification of the persons responsible for the maintenance of the system, copies of mail ledger, docket sheets, file wrappers;*
- 6) *an indication why the system failed; and*
- 5) *information regarding the training provided to the clerk(s) responsible for the docketing error, the degree of supervision of their work.*

As petitioners have outlined the procedures employed by the staff at the Artz Firm, including Ms. Ford, petitioners have also not provided any evidence that the system in place incorporated the necessary checks and balances to prevent such a failure in the payment of maintenance fees as occurred in this instance. The use of a reliable system could have apprised the Artz firm that the maintenance fee had not been paid. According to the evidence provided, if the instruction was given to pay the maintenance fee, it was assumed that it had been paid. Such a system calls into question whether or not Ms. Ford was properly supervised and thus the lack of proper supervision could easily have been the cause of the delay and thus could not be deemed an unavoidable delay.

As indicated in the case citations above, courts have adopted the "reasonably prudent person" standard in determining whether a delay was "unavoidable" within the meaning of the statute. To establish that the delay was unavoidable, petitioners must show that the parties responsible for payment of the maintenance fee exercised that degree of care or diligence that "is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, *supra* (emphasis added).

### CONCLUSION

The prior decision which refused to accept under § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b).

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<sup>2</sup> See, e.g., *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff* 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Since this patent will not be reinstated, the maintenance fee and the surcharge fee submitted by petitioners will be credited to deposit account no. 50-0476.

As stated in 37 CFR 1.378(e), no further reconsideration or review of this matter will be undertaken.

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

A handwritten signature in dark ink, appearing to read "Charles Pearson", followed by a long horizontal line extending to the right.

Charles Pearson  
Director, Office of Petitions  
Office of the Deputy Commissioner